

Serial No. 10/556,357; Reply to Action of 11/12/08

REMARKS

Claims 7-12 and 20-22 are pending in this patent application, with claims 1-6, 13-19 and 23 are withdrawn from consideration. Claims 7-12 and 20-22 are under consideration.

Claim 7 is now amended to recite "a second gap, provided between the stator and the rotor and communicating with the inner space inside of the cylindrical dividing member, the second gap being operable to return oil to the oil reservoir." The Examiner is referred to Fig. 10, in which gap 18 exemplifies the claimed second gap, described in the last full paragraph on page 39 of the specification. Fig. 10 shows that gap 18 communicates with the exemplary inner space 19. The previously-claimed gap is now renamed as a "first" gap to distinguish the two gaps.

In response to the outstanding Office Action:

(1) The Examiner notes the election of claims 7-12 and 20-22 (Group II).
(2, 12) The Examiner states that she has not considered the IDS of November 10, 2008, on the basis that no legible copies of foreign patents were attached. However, the Examiner has obtained those references, cited them in her PTO 892 form, and also initialed the PTO-1449 form which she had received without the references, which apparently were separated from the IDS.

Because of this action by the Examiner, the references are of record and under the consideration. The Examiner is thanked for resolving this problem.

(3) The drawings are objected to. The Examiner asserts that Figs. 19-21 should be labeled as "prior art." These figures will be submitted in due course with such labels.
(4) A more-descriptive title was required. The title is amended as required.

Serial No. 10/556,357; Reply to Action of 11/12/08

(5-7) Claims 7-10 and 20 are rejected under 35 U.S.C. §102(b) as being anticipated by Kawabe, JP 2002-235666; Claims 7-8 are rejected under 35 U.S.C. §102(b) as being anticipated by Sakaino JP 58-170893; Claims 7-10 are rejected under 35 U.S.C. §102(b) as being anticipated by Muramatsu et al., JP 61-205392. These rejections are respectfully traversed on the basis, *inter alia*, of the present amendment.

In each of the references the gap between the stator and the rotor is on the *outside* of the asserted cylindrical dividing member, while in the Applicants' compressor the gap between the stator and the rotor is on the *inside* of the dividing member (e.g., in Fig. 10 gap 18 is of a smaller radius than dividing member 41, and therefore inside it). This arrangement provides the advantage of a return path for the oil. The Applicants' specification explains that the centrifugal and surface effects of the spinning top of the rotor tend to collect droplets of oil and throw them to the outside of the rotor. Stopped from further outward travel by the dividing member, the oil may return to the oil reservoir through the narrow gap 18 between the rotor and the stator.

The last full paragraph on page 39 (¶ [0141]) explains that "With the above effect, the refrigeration oil which grew into the liquid drop from the fog drip and which was separated from the working fluid passes through the gap 18 between the stator 11 and the rotor 12 by the gravity, and is returned into the oil reservoir 16 formed in the bottom of the hermetical container 1. The working fluid having smaller centrifugal force caused by turning flow than the refrigeration oil and collected to the center of the inner space 19a of the thin cylinder 41 is introduced into the suction port 40a of the discharge pipe 40 in a state where the refrigeration oil is separated from the working fluid."

Neither the Applicants' advantage nor the claimed structure is disclosed, and therefore there is no anticipation of amended claim 7.

Serial No. 10/556,357; Reply to Action of 11/12/08

(8) Claim 11 is rejected under 35 U.S.C. §103(a) as being obvious over Kawabe in view of case law. This rejection is respectfully traversed on the basis of the present amendment and the arguments above, and on the further basis that the claimed location increases the diameter of the cylindrical dividing member, which has an effect on the action of the working fluid. With respect, the Examiner has merely asserted that the dividing member would perform the same way in the claimed position as elsewhere, but has not presented any evidence that this is actually the case.

(9) Claim 12 is rejected under 35 U.S.C. §103(a) as being obvious over Kawabe in view of case law. This rejection is respectfully traversed.

Claim 12 recites that "an inner diameter of an upper portion of said dividing member is smaller than an inner diameter of a lower portion of said dividing member." This shape is clearly seen in Fig. 10, where the upper part of dividing member 41 is converging, approximately as a truncated cone.

The advantage of this shape is explained paragraph spanning pages 138-139 of the specification.

The Examiner asserts that "Kawabe fails to disclose a shape of the dividing member." The Applicants respectfully disagree. The shape of the dividing member Sa is clearly shown.

The Examiner further asserts that changing shape requires only routine skill in the art. However, the rejection is respectfully submitted not to have met the standard required by MPEP § 2141, under which the Examiner must apply one of the rationales A-G. The MPEP states that "The 'mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness.' *Dann v. Johnston*, 425

JAN 22 2009

Serial No. 10/556,357; Reply to Action of 11/12/08

U.S. 219, 230, 189 USPQ 257, 261 (1976). The gap between the prior art and the claimed invention may not be [too great]."

(10-11) Claim 21 is rejected under 35 U.S.C. §103(a) as being obvious over Kawabe in view of case law; Claim 22 is rejected under 35 U.S.C. §103(a) as being obvious over Kawabe in view of Yamasaki, US 6,732,542. These rejection are respectfully traversed on the basis, *inter alia*, of the present amendment.

In view of the aforementioned amendments and accompanying remarks, claims, as amended, are in condition for allowance, which action, at an early date, is requested.

Respectfully submitted,

KRATZ, QUINTOS & HANSON, LLP



Nicholas S. Bromer
Attorney for Applicants
Reg. No. 33,478

NSB/lrj

Atty. Docket No. 050719
Suite 400
1420 K Street, N.W.
Washington, D.C. 20005
(202) 659-2930

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